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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,546	06/05/2001	Dan Kikinis	004688.P023	6897
33448	7590	04/07/2005	EXAMINER	
ROBERT J. DEPKE LEWIS T. STEADMAN HOLLAND & KNIGHT LLC 131 SOUTH DEARBORN 30TH FLOOR CHICAGO, IL 60603			LAYE, JADE O	
		ART UNIT		PAPER NUMBER
		2614		
DATE MAILED: 04/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/875,546	KIKINIS, DAN
	<b>Examiner</b>	<b>Art Unit</b>
	Jade O. Laye	2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 June 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/15/01, 7/19/01, 8/28/01, i/30/02</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 6/5/01, 7/19/01, 8/28/01, and 1/31/02 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

### ***Drawings***

2. The drawings are objected to because the system components are not descriptively labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7-11, 15-19, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson. (US Pat. No. 5,710,605).

As to claim 1, Nelson discloses a remote controller for an interactive television system. The system comprises a video display, receiver, and a remote controller (i.e., computing device), which displays an EPG; thereby allowing the user to search the EPG while viewing broadcast programming on the television display. (Abstract; Fig. 1; Col. 1, Ln. 10-13, 33-41, & 64-67 thru Col. 2, Ln. 1-9). Although not explicitly disclosed, it is inherent the system contain a receiver for receiving the satellite broadcasts disclosed at Col. 1, Ln. 33-41. Therefore, Nelson anticipates each and every limitation of claim 1.

Claims 9 and 17 correspond to the system claim 1. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 2, Nelson further teaches the EPG can be displayed on the television display, while simultaneously being displayed on the remote controller. (Col. 6, Ln. 6-8 & Fig. 4). Therefore, Nelson anticipates each and every limitation of claim 2.

Claims 10 and 18 correspond to the system claim 2. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 3, Nelson further teaches the remote controller receives the EPG via a modem secured to a telephone line. (Col. 1, Ln. 64-67 thru Col. 2, Ln. 1-9). Therefore, Nelson anticipates each and every limitation of claim 3.

Claims 11 and 19 correspond to the system claim 3. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 7, Nelson further teaches the video display can be a television. (Abstract). Therefore, Nelson anticipates each and every limitation of claim 7.

Claims 15 and 23 correspond to the system claim 7. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 8, Nelson further teaches the remote controller can be used in conjunction with satellite systems. (Col. 1, Ln. 33-41). It is inherent the satellite system contain some sort of receiver for demodulating and/or demultiplexing the satellite signal. Therefore, Nelson anticipates each and every limitation of claim 8.

Claims 16 and 24 correspond to the system claim 8. Accordingly, each is analyzed and rejected as previously discussed.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 4, 5, 12, 13, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Shen et al. (US Pat. No. 6,401,059).

Claim 4 recites the system of claim 2, wherein the computing device is a wireless device. As discussed above, Nelson discloses all limitations of claim 2, but fails to specifically teach the limitation of claim 4. However, within the same field of endeavor, Shen et al disclose a similar system in which the computing device is a wireless PDA. (Abstract; Col. 1, Ln. 53-67). Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Nelson and Shen in order to provide a PDA which also functions as a remote controller, thereby providing a user with extended functionality.

Claims 12 and 20 correspond to the system claim 4. Accordingly, each is analyzed and rejected as previously discussed.

Claim 5 recites the system of claim 2, wherein the computing device is a Personal Device Assistant (PDA). As discussed above, Nelson discloses all limitations of claim 2, but fails to specifically teach the limitations of claim 5. However, within the same field of endeavor, Shen et al disclose a similar system in which a PDA is utilized as a remote controller within a television broadcast system. (Abstract; Col. 1, Ln. 53-67). Therefore, it would have been

obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Nelson and Shen in order to provide a PDA which also functions as a remote controller, thereby providing a user with extended functionality and control.

Claims 13 and 21 correspond to the system claim 5. Accordingly, each is analyzed and rejected as previously discussed.

5. Claims 6, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Elliot. (US Pat. No. 6,473,097).

Claim 6 recites the system of claim 2, wherein the computing device is a Web Phone. As discussed above, Nelson discloses all limitations of claim 2, but fails to specifically teach the limitations of claim 6. However, within the same field of endeavor, Elliot discloses a cellular phone which can receive/transmit data from/to the Internet via radio frequencies. (Col. 3, Ln. 35-45 & Col. 4, Ln. 36-46). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Nelson and Elliot in order to provide a system capable of utilizing a mobile phone having EPG capability as a remote controller, thereby providing the user with extending functionality and control.

Claims 14 and 22 correspond to the system claim 6. Therefore, each is analyzed and rejected as previously discussed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Escobar et al (US Pat. Pub. No. 2002/0053084) disclose an EPG capable of storing program selections at the subscriber site.
- b. Terakado et al (US Pat. No. 6,246,441) disclose a system comprising a remote terminal capable of displaying an EPG.
- c. Darbee et al (US Pat. No. 6,130,726) disclose a remote capable of displaying an EPG.
- d. Shintani et al (US Pat. No. 6,532,592) disclose a remote capable of displaying an EPG.
- e. Gudorf (US Pat. No. 6,313,887) discloses a remote capable of displaying data.
- f. Schultz et al (US Pat. No. 5,679,943) disclose a hand held terminal capable of a variety of functions, one of which is receiving/displaying EPG data.
- g. Croy et al (US Pat. No. 6,509,908) disclose a remote capable of displaying an EPG.
- h. Kim (US Pat. No. 6,556,771) discloses a remote capable of displaying an EPG.
- i. Sorensen (US Pat. No. 6,628,729) discloses a remote capable of displaying an EPG.
- j. Maissel et al (US Pat. No. 6,637,029) disclose an intelligent EPG.
- k. Grooters (US Pat. No. 6,862,741) discloses a remote capable of displaying an EPG.
- l. Huang et al (US Pat. No. 6,437,836) disclose a PDA capable of displaying an EPG.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials JL  
March 25, 2005.



NGOC-YEN VU  
PRIMARY EXAMINER